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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,782	10/19/2000	Scott R. Smith	760-3 RES	3708

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HOFFMANN & BARON, LLP
6900 JERICHO TURNPIKE
SYOSSET, NY 11791

EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691,782

Applicant(s)

Smith et al.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 18, 2002
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14 is/are allowed.
- 6) ☒ Claim(s) 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Certificate of Correction changes made in the patent must be incorporated into the reissue application. However, note that these changes must be made without underlining or bracketing.

Applicant is requested to submit a PTO-1449 form including all references cited in the patent.

Claim 15 should be completely underlined since it does not appear in the patent.

Claims 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The seam defined in claim 18 has already been defined in claim 15 resulting in a double recitation of the same element.

Claims 15-21 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the

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prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. During the original prosecution of applicant's patent (Patent No. 5,824,046), originally filed claims 1-23 were rejected by the examiner in the Office Action mailed April 17, 1997, as being unpatentable over Myers et al. (WO 95/05132) in view of Hubis (4,478,665) under 35 U.S.C. 103(a). In an amendment filed Oct. 20, 1997 replying to that Office Action, applicant added the limitation to claim 1:

"wherein said stent covering includes an elongate segment of said unsintered ePTFE having an original longitudinal expanse, said segment being expanded in a transverse direction so as to reduce said original longitudinal expanse, said segment being positioned generally transverse to said longitudinal stent axis, and being expandable longitudinally upon said radial expansion of said stent to return said expanded segment to said original longitudinal expanse to thereby control said radial expansion of said stent".

On pages 4-7 of that amendment, applicant argued that the claims were patentable because the above limitation was not found in the prior art. In the reasons for allowance, the examiner indicated that the claims were patentable essentially because the above limitation was not found in the prior art. Claims 15-21 of the present application fail to include this limitation. Since applicant narrowed the claims for the purpose of obtaining allowance in the original prosecution, applicant is now precluded from recapturing subject matter previously surrendered.

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Claims 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers et al. (WO 95/05132) in view of Hubis (4,478,665). Myers et al. show stent 10 and stent cover 20 formed of ePTFE having a longitudinal expanse and a transverse expanse which is expandable along said transverse expanse upon radial expansion of stent. Myers et al. fail to show the ePTFE as being unsintered. Hubis teaches that ePTFE articles such as films and tubes used in the medical field may be unsintered rather than sintered (col. 1, lines 20-30 and col. 3, lines 45-46). This results in the self-evident advantage of not having expend the time, energy and money involved in the sintering process. It would have been obvious to use unsintered ePTFE as the material for the Myers stent cover 20 so that it too could enjoy this advantage.

Claims 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banas et al. (5,749,880). Banas et al. show stent 10 and stent cover 26 formed of unsintered ePTFE (col. 13, lines 34-41). Although the stent cover 26 is later sintered (col. 13, lines 56-57), the Banas et al. stent and stent cover prior to this sintering meet this limitation in the claims. Banas et al. fail to show the stent cover having a seam formed by opposing overlapping edges. Including such a seam in the Banas et al. stent cover in order to conveniently secure the stent cover on the stent would have been obvious, particularly since it is well known in the art to so construct stent covers for this reason.

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Claims 1-14 are allowed.

Applicant's arguments filed April 18, 2002 have been fully considered but they are not persuasive. As to the rejection based upon 35 U.S.C. 251, a limitation which was added during prosecution of the issued patent has been omitted from the reissue claims as agreed by applicant on page 4 of the response. Further, this limitation was added during prosecution of the issued patent in order to make the claims allowable over a rejection made in the original application. Since applicant narrowed the claims for the purpose of obtaining allowance in the original prosecution, applicant is now precluded from recapturing subject matter previously surrendered. Even if the reissue claims are more narrow than the originally filed, unamended claims, the reissue claims are broader than the narrowed patent claims which applicant submitted in order to make the claims allowable over a rejection made in the original application. Thus, applicant is precluded from recapturing subject matter previously surrendered. As to the argument on page 6 of the response that there is no expansion of the ePTFE cover of Myers since it simply returns to its original state, it is submitted that the cover in Myers is "expandable along said transverse expanse", as broadly claimed in claim 15 since it expands when the stent increases its diameter as described on page 9, lines 19-22, for example. Even if some slack exists in the Myers cover when the stent/graft is radially reduced, the cover still

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expands from a small diameter to a large diameter when the stent expands. As to the argument on page 8 of the response that the ePTFE cover of the present invention provides for radial expansion without deformation while the Banas et al. graft may only expand by radially deforming it, it is submitted that the amount of deformation, if any, of the cover during expansion has not been claimed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

mht
June 3, 2002
FAX (703) 305-3590



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731